



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,457	06/14/2001	Mark D. Cochran	SY01105K1QKQK	7533

24265 7590 09/12/2002

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER

SALIMI, ALI REZA

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 09/12/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/881,457

Applicant(s)
Cochran et al

Examiner
A. R. SALMI

Art Unit
1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 14, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

Art Unit: 1648

DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1648.

Claims 1-39 are pending.

Raw Sequence Listing have been entered.

Submitted Information Disclosure Statement (I.D.S) is noted.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). Please update the current status of the priority application by inserting the patent numbers as well as abandoned information.

Art Unit: 1648

Claim Rejections - 35 USC § 112

Claims 1-9, 11-14, 16, 18-25, 27-29, 31-33, 35-37, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite the intended metes and bounds of “unique long and repeat”, “Marek’s disease virus “unique short viral genome”, are not defined. There are multiple long regions and multiple short regions present within the HVT and Marek’s’s disease virus respectively. It is not clear which regions are forming the chimeric virus. How can a proper search be conducted if the regions are not defined so to distinguish this chimeric virus verses the multitudes of HVT/MDV chimeras? The regions should be identified with appropriate sequence identification numbers. This affects the dependent claims.

Applicants are reminded that the priority for the claimed invention is determined to be the date of filing for this application, 06/14/2001. If applicants disagree with this determination, please point to specific pages of a priority document(s) that provides support for the now claimed invention. In addition, if applicants disagree with the determination please provide specific reasoning why the claims are entitled to priority prior to 06/14/2001.

Art Unit: 1648

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9, 11, 13, 18, 20, 24, 25, 28-29, 32-33, 36, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Cochran et al (US Patent No. 5,965,138).

The product disclosed in the above cited patent appears to be identical or so similar that is indistinguishable from the product claimed by the applicants (see the claims, and "EXAMPLE 19"). Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Hence, the disclosure of the above cited patent anticipates the claimed invention. Again, applicants are reminded that the intended use of a product does not carry patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1648

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran et al (US Patent No. 5,965,138) and Kingham et al (Journal of General Virology, May 2001, Vol. 82, 1123-1135) .

Cochran et al taught recombinant chimeric virus which is "novel avian virus" by fusing two separate regions of two different yet highly homologous viruses to form an expression vector to be employed in expression of foreign antigens to induce immune response. This differs since they did not teach specific vectors now recited.

Kingham et al taught the complete sequence of herpesvirus of turkey (HVT), its unique long along with repeat regions. They disclosed the various ORFs and facilitated the coordinates of start and stop nucleotide for said virus including US2 region (see Table 2). In addition, they taught the similarity that existed among the HVT also known as MDV3 and other Marek's's disease virus such as MDV-1, and MDV-2 (see the abstract). This differs since they did not teach a chimeric expression vector.

Therefore, it would have been obvious for one of ordinary skill in the art to follow Cochran et al teaching while knowing the exact coordinates provided by Kingham et al to form an expression vector to induce immune response in birds. One of ordinary skill in the art being familiar with the cited art would not have anticipated any unexpected results. Thus, the invention as a whole is prima facie obvious absent unexpected results.

Art Unit: 1648

No claims are allowed.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-3014, or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. R. Salimi

9/10/2002


ALI R. SALIMI
PRIMARY EXAMINER